REMARKS

By this paper, claims 1, 28, 55, and 82 have been amended. No new matter has been added. Reconsideration and allowance of the claims in light of the amendments and remarks herein are respectfully requested.

Rejection under 35 U.S.C. § 101

Claims 1-3, 5-30, 32-57, 59-84, and 86-108 stand rejected as directed towards non-statutory subject matter. It is the examiner's position that claims 1, 28, 55, and 82 recite an abstract idea including steps that do not apply, involve, use, or advance the technological arts. It is also the examiner's position that claims 2-3, 5-27, 29-30, 32-54, 56-57, 60-81, 83-84 and 87-108 inherit the deficiency through dependency. The examiner states that the cited deficiency may be overcome by expressly stating the use of a technological art.

Applicants submit that the 35 U.S.C. § 101 rejection should be withdrawn. A claimed process that is considered to manipulate an abstract idea must be limited to a practical application of the idea to be considered statutory. *In re Alappat*, 33 F.3d 1526, 1543 (Fed. Cir. 1994). A claim is limited to a practical application when the method produces a concrete, tangible, and useful result. MPEP § 2106; *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358 (Fed. Cir. 1999).

In rejecting claim 1, the examiner states that the recited process of claim 1 does produce a useful, concrete and tangible result ("the claimed invention of a method for claims data analysis produces an optimal best practice of analyzing claim data"). As the examiner notes, therefore, claim 1 is limited to a practical application and should be considered statutory subject matter. Indeed, only when a claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. § 101. MPEP § 2106; *In re Musgrave*,

431 F.2d 882, 893 (CCPA 1970). Accordingly, withdrawal of the 35 U.S.C. § 101 rejection of claim 1 is respectfully requested. Because the examiner applies a similar analysis for claim 1 to claims 28, 55 and 82, and dependent claims 2,3, 5-27, 29, 30, 32-54, 56, 57, 60-81, 83, 84, and 87-108, withdrawal of the 35 U.S.C. § 101 rejection of these claims is also respectfully requested. Accordingly, for this reason, the rejection of claims 1-3, 5-30, 32-57, 59-84, and 86-108 should be withdrawn.

Notwithstanding the above reasons, applicants also submit that amended claims 1, 28, 55, and 82 recite more than a mere abstract idea and include limitations for producing a useful, concrete, and tangible result. Indeed, amended claims 1, 28, 55, and 82 include the limitation for "providing responses into a data processing system." These claims, therefore, are not merely performed in the mind of the user or by use of a pencil and paper. Accordingly, for this reason, reconsideration of the 35 U.S.C. § 101 rejection of claims 1-3, 5-30, 32-57, 59-84, and 86-108 is respectfully requested and allowance of these claims is earnestly solicited.

Rejection under 35 U.S.C. § 103

Claims 1-3, 5-23, 27-30, 32-50, 54-57, 59-77, 81-84, 86-104 and 108 stand rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Hammond et al., U.S. Pat. No. 5,712,984 ("Hammond") in view of Moore et al., U.S. Pat. No. 5,930,759 ("Moore"), and in further view of Little, et al. U.S. Pat. No. 5,359,509 ("Little"). Claims 4, 24-26, 31, 51-53, 58, 78-80, 85, 105-107 stand rejected pursuant to 35 U.S.C. § 103 as being unpatentable over Hammond, Moore, and Little as applied to claims 1, 28, 55, and 82, and in further view of Fatseas U.S. Pat. No. 5,671,409 ("Fatseas").

First, applicants submit that the prior art does not provide a suggestion or motivation to combine the cited references. Hammond relates to a system for using data to create statistical

models to predict future incurred costs and durations for a carrier's worker's compensation claims. (Fig. 1; col. 3, ll. 36-40). Moore relates to a network for electronically assembling, filing, and processing health care data transactions and insurance claims. (Fig. 1; col. 4, ll. 43-45). Little discloses a computer system that reviews and adjudicates medical health care payment requests to minimize fraud and mistakes and to determine whether to honor the request and a dollar amount of the payment, if the request is honored. (Abstract; col. 6, ll. 44-47). Fatseas merely discloses a computer system that provides a user with information about various career opportunities, and does not disclose a system used to process a claim or analyze previously processed claims. (col. 1, ll. 8-10). Whereas Moore and Little disclose systems for processing claims, Hammond discloses a system that makes future predictions based on claims that have already been processed. All of the prior art references, therefore, apply to methods used for claim administration – i.e. "setting loss reserves" (col. 2, l. 2), preparing and processing health care data transactions and insurance claims (col. 2, l. 2), or a payment request adjudication method and apparatus (col. 4, l. 24). The cited references, either singly or in combination, do not relate to reviewing the claims handling process more completely in order to given an insurance company an idea of what company practices are beneficial, or whether the amount claims paid out on the claims were appropriate as described for the present invention. (page 1). Accordingly, the cited references do not relate to the present invention, and therefore, there is no motivation or suggestion in the prior art to combine the teachings of Hammond with Moore, Little and Fatseas to produce the present invention. Applicants, therefore, respectfully request reconsideration of the 35 U.S.C. § 103 rejection of claims 1-108.

Applicants also submit that the cited prior art does not disclose or suggest the limitations of amended claim 1. Hammond discloses determining various statistics such as means,

variances, maximums, and minimums from variables and flagging improper values such as a negative or zero cost, which are all related to costs, (col. 6, ll. 17-23 and 39-43), and does not disclose or suggest determining loss economic opportunity. Similarly, Little discloses "lowering administrative costs" through "review and adjudication" of payment requests "to reduce fraud and unintentional errors and provide consistency in payment," (col. 1, ll. 36, 42, col. 17, ll. 21-33), and does not disclose determining a best practice. Indeed, Hammond, Moore and Little do not disclose "associating at least one practice from a predetermined set of best practices with the responses" to queries relate to claim information, as recited in amended claim 1. Therefore, even if one skilled in the art would combine Hammond with Moore and Little, the combination does not include the limitations for "associating at least from a set of predetermined practices with the responses." Indeed, the prior art, and particularly Hammond, Moore and Little, do not disclose claim data analysis including the limitation for "and "determining a best practice based on loss economic opportunity," as also recited in amended claim 1. Therefore, applicants respectfully request withdrawal of the rejection of claim 1.
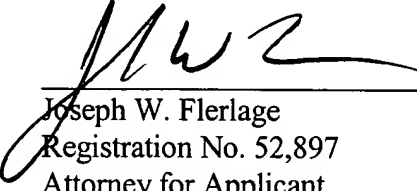
With respect to claims 28, 55, and 82, the examiner has rejected these claims for the same reasons given for claim 1. Claims 28, 55, and 82 recite similar limitations noted above for claim 1. Accordingly, for the reasons presented above for claim 1, the prior art does not disclose or suggest these limitations of claims 28, 55, and 82.

With regard to claims 2-27, 56-81, and 83-108, because the prior art does not disclose the limitations of independent claims 1, 28, 55, and 82, the prior art also does not disclose the limitations of the claims dependent therefrom. Therefore, claims 2-27, 56-81, and, 83-108 would not have been obvious to one skilled in the art at the time of invention. Accordingly, reconsideration of the rejection of claims 2-108 is respectfully requested.

In view of the amendments and reasons presented herein, withdrawal of the 35 U.S.C. §§ 101 and 103(a) rejections is respectfully requested and allowance is earnestly solicited. Should the examiner deem a telephone conference to be beneficial in expediting allowance of the application, the examiner is invited to call the undersigned attorney at the telephone number listed below.

Respectfully submitted,

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APPENDIX A

1.   (Amended) A method for claims data analysis, comprising the steps of:

receiving information associated with a plurality of claims;

providing responses into a data processing system in response to a set of queries associated with the information;

associating at least one practice from a predetermined set of best practices with the responses;

determining a loss economic opportunity associated with processing the plurality of claims based on the responses; and

determining a best practice based on the loss economic opportunity.

28.   (Amended) An apparatus for claims data analysis, comprising:

a receiving module for receiving information associated with a plurality of claims;

a providing module for providing responses into a data processing system in response to a set of queries associated with the information;

an associating module for associating at least one practice from a predetermined set of best practices with the responses;

a determining module for determining a loss economic opportunity associated with processing the plurality of claims based on the responses; and

a determining module determining a best practice based on the loss economic opportunity.

55.   (Amended) A computer-readable medium containing instructions for claims data analysis, comprising:

receiving information associated with a plurality of claims;

providing responses into a data processing system in response to a set of queries associated with the information;

associating at least one practice from a predetermined set of best practices with the responses;

determining a loss economic opportunity associated with processing the plurality of claims based on the responses; and

determining a best practice based on the loss economic opportunity.

82. (Amended) A system for claims data analysis, comprising:

means for receiving information associated with a plurality of claims;

means for providing responses into a data processing system in response to a set of queries associated with the information;

means for associating at least one practice from a predetermined set of best practices with the responses;

means for determining a loss economic opportunity associated with processing the plurality of claims based on the responses; and

means for determining a best practice based on the loss economic opportunity.